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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,370	06/02/2006	Paul Hansen	7744P002	9736
8791 7590 08/29/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER WONG, LUT				
ART UNIT 2129		PAPER NUMBER		
MAIL DATE 08/29/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,370

Applicant(s)

HANSEN ET AL.

Examiner

LUT WONG

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14, 40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/CDC)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to an AMENDMENT entered Jul 25, 2008 for the patent application 10/561370.

Status of Claims

Claims 1-4, 6-14, and 40 are pending. Claim 5 is cancelled.

Response to Arguments

In re pg. 11, applicant's cooperation is appreciated. The objection and rejection of claim 5 are hereby withdrawn.

The Examiner thanks the applicant for pointing out that claim 27 was cancelled and replaced by claim 40. It was a typo in the action summary.

Claim Rejections - 35 USC § 112

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as set forth in the previous office action.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In re pgs. 11-13, the applicant attempts to explain that the antecedent basis for "the reverse strict ordinal ranking" is "a strict ordinal ranking".

In response, the Examiner disagrees. If the claim limitation is "the strict ordinal ranking" without the "reverse", then the Examiner would agree there is antecedent basis. Perhaps the applicant can amend the claim to 'a reverse strict ordinal ranking' instead to overcome the rejection.

Claim Rejections - 35 USC § 101

Claims 1-4, 6-14, 40 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter as set forth in the previous office action for reason of record.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In re pgs. 13-17, applicant argues that the claimed invention is not abstract idea per se, produce a concrete result, and not preemption.

In response, the Examiner disagrees.

1) The method of claim 1 can be done by merely thinking about it, which fails to fall within statutory process. The Examiner suggests amending it to "computer implemented" to overcome the rejection.

2) Regarding abstract idea, the method merely compares some profiles and solving some equations. Such method is considered as abstract idea by performing data manipulation using some math algorithm.

3) Regarding concrete result, it is hardly convincing that given same input, the decision maker would give same output. Especially in case of ranking "undominated

profile pairs" (See applicant's spec pg. 12 L10- pg 13 L10 on "undominated pairs" description), the decision maker has to rank them explicitly via value judgments (See spec pg.12 L12-19). Perhaps the applicant can add some objective criteria from the spec into the claim to overcome the rejection.

4) Regarding preemption, perhaps the applicant can amend the claim by adding practical applications from the spec pg. 9, L 16-20 to overcome the rejection.

Claim Rejections - 35 USC § 102

Claims 1-14, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Behnam Malakooti as set forth in the previous office action for reasons of record.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In re pg 17-30, applicant's argument can be summarized as 1) teach away from the invention 2) not the same algorithm 3) less effective.

In response,

1) While Malakooti's main focus is not on pairwise ranking, Malakooti nonetheless teaches pairwise ranking. A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. See MPEP 2131.05 [R-5].

2) Applicant seems to read too much limitation from the spec into the claim.

Applicant is reminded that the claims and only the claims form the metes and bounds of the invention. Limitations appearing in the specification but not recited in the claim are not read into the claim. The Examiner has full latitude to interpret each claim in the broadest reasonable sense. There is no mention of these limitations in the claims and the specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding the prior art; see In re Sprock, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

3) Perhaps the applicant can further define "undominated profile pairs" (see spec pg. 12) and how it is generated (such as claim 8), "the system of equalities/inequalities" (such as claim 13) into independent claims to overcome the rejection.

Examiner Note

The Examiner already made suggestions on how to overcome 101 and 102 rejections. In order to receive favorable consideration, the applicant is encouraged to consider the suggested solutions.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lut Wong whose telephone number is (571) 270-1123. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent David can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lut Wong/
Patent Examiner, AU 2129

/David R Vincent/
Supervisory Patent Examiner, Art Unit 2129